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Patent
Attorney Docket No. GEMS8081.023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Durbin et al.
Serial No. : 09/681,017
Filed : November 22, 2000
For : METHOD AND SYSTEM TO REMOTELY ENABLE
SOFTWARE-BASED OPTIONS FOR A TRIAL PERIOD
Group Art No. : 3621
Examiner : Calvin Loyd Hewitt II

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

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- ☐ deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- 37 CFR 1.8(a) 37 CFR 1.10**
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- Transmission**
- ☒ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Office of Petitions at the Patent and Trademark Office.

Date: 10/2/08


Signature

Commissioner for Patents
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**RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND
RULES OF 37 C.F.R. §1.131 and 37 C.F.R. §1.48**

Dear Sir:

In response to the Decision on Petition mailed August 5, 2008, Applicant submits this Renewed Petition under 37 C.F.R. § 1.183. Applicant respectfully requests suspension of the requirements of 37 C.F.R. § 1.131 and 37 C.F.R. § 1.48 in order to proceed with a renewed Antedating Declaration without the signatures of joint inventors Winnie Durbin, Karamjeet Singh, and Kun Zhang.

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S/N: 09/681,017

REMARKS

Applicant hereby renews the petition for suspension of the requirement of 37 C.F.R. §1.131 that all joint inventors must participate in a Declaration establishing invention of the claimed subject matter prior to the effective date of a cited reference. Applicant also hereby petitions for suspension of the requirement of 37 C.F.R. 1.48 that all joint inventors must participate in a Declaration to correct inventorship. Joint inventors Winnie Durbin, Karamjeet "KJ" Singh, and Kun Zhang are no longer employed by the Assignee of the present application. Joint inventors Durbin, Singh, and Zhang have been unreachable, despite numerous attempts to make contact. As is set forth in a concurrently-filed Petition to Correct Inventorship under 37 C.F.R. § 1.48, four (4) inventors were mistakenly omitted from the application as originally filed. These four inventors (David T. Mehring, Thomas L. Lamoureux, Hubert A. Zettel, and Timothy D. Butler) have agreed to sign the antedating declaration under 37 C.F.R. §1.131.

In the Decision on Petition mailed August 4, 2008 ("the Decision"), Applicants previous petition under 37 C.F.R. 1.183 and 37 C.F.R. 1.48(a), dated May 12, 2008, was dismissed. While the Decision accepted that Applicant had shown that Inventor Zhang was unreachable, the reason given for dismissal of the renewed petition was that "[p]etitioners have not established that Inventors Singh and Durbin have refused to execute a declaration for the patent application." *Decision*, August 4, 2008, p. 2. In regard to Inventor Singh, the Decision stated that "his unwillingness to execute the 131 declaration presented to him in February 2007 does not prove that he would refuse to sign a declaration that lists him as a joint inventor." *Id.* As for Inventor Durbin, the Decision stated that "[h]er husband cannot refuse to cooperate on her behalf." *Id.*

First, it is noted that Applicant did not submit that the husband refused to cooperate on Inventor Durbin's behalf, but more accurately set forth facts that the husband relayed his wife's desires to not cooperate. There is a distinction that should not be overlooked. That is, the Decision states that "Inventor Durbin has not refused to cooperate" and that "[h]er husband cannot refuse to cooperate on her behalf." *Id.* That is simply not the case – Inventor Durbin's husband relayed the message from his wife that his wife did not wish to assist. The Office cannot state that a husband cannot relay his spouse's desire to not be contacted and to therefore not cooperate particularly when the husband is the only known connection to the spouse. Such evidence is at least as strong as the suggested mailing, if not stronger.

Second, Applicant believes that the statement in the Decision that "emailing is generally not accepted as a means to communicate with non-signing inventors" is outdated, and inconsistent with general business practices and the Office's own practice. *See Id.* at 3. As the

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Decision did not specifically cite where such a USPTO guideline or regulation is spelled out, Applicant requests reconsideration and authoritative support for the statement. The USPTO itself has made email with Applicants the preferred method of communication in nearly every aspect of patent prosecution. If the USPTO did not trust that emails could be properly viewed and considered by Applicants, the Office would certainly not rely so heavily on email communication in its everyday operations. Further, in view of modern business practices, the likelihood of a postal communication being lost or unread is at least equal to that of an email being lost or unread. Accordingly, Applicant believes that the email communications set forth as evidence in the previous Petition should be considered sufficient. Regardless of Applicant's disagreement with respect to the necessity of the suggestions made in the Decision, in the interest reducing further delay, Applicant has additionally complied with the suggestions outlined in the Decision. Specifically, in order to prove that the listed inventors were unreachable or unwilling to sign, the Decision suggested the following:

"Petitioners should mail a copy of the complete application papers (specification, claims, and drawings) and the May 12, 2008 declaration to the last known addresses of Inventors Singh and Durbin, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting forth a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct."

Id. at 2. Accordingly, Applicant submitted these suggested documents to the last known addresses of Inventors Singh and Durbin, as will be set forth in more detail below.

Regarding Inventor Singh, Applicant mailed a letter, along with the Declaration of Inventorship and the Rule 1.131 Declaration, via certified mail to his last known address on August 20, 2008. The letter, submitted herewith as Exhibit A, detailed the reasons for the requirement of his signature and set a response due date of September 10, 2008. However, the letter was returned to the Applicant as undeliverable by the U.S. Postal Service on August 27, 2008. A copy of the return receipt is submitted herewith as Exhibit B. As such, Applicant believes that the returned letter shows that Inventor Singh is unreachable, and thus Applicant respectfully requests that the Office grant the petition to suspend the requirement of 37 C.F.R. §1.131 that Inventor Singh must participate in a Declaration establishing invention.

Likewise, in regard to Inventor Durbin, Applicant also mailed a letter, along with the Declaration of Inventorship and the Rule 1.131 Declaration, via certified mail to her last known address on August 20, 2008. The letter, submitted herewith as Exhibit C, detailed the reasons for

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S/N: 09/681,017

the requirement of her signature and set a response due date of September 10, 2008. However, the letter was similarly returned as undeliverable by the U.S. Postal Service on August 26, 2008. A copy of the return receipt is submitted herewith as Exhibit D. As such, Applicant believes that the returned letter shows that Inventor Durbin is unreachable or refused to accept the certified letter, and thus Applicant respectfully requests that the Office grant the petition to suspend the requirement of 37 C.F.R. §1.131 that Inventor Durbin must participate in a Declaration establishing invention.

As neither Inventor Singh nor Inventor Durbin was able to be reached at their respective last known addresses, Applicant believes that the requirement to show that the inventors did not respond to the request that they sign the declarations within a reasonable amount of time has been satisfied. As the Decision stated:

"Inventors Singh and Durbin should be mailed a copy of the application, along with a copy of the May 12, 2008 declaration for patent application and a copy of the May 12, 2008 Rule 131 declaration for their execution. When petitioners can show that Inventors Singh and Durbin were successfully mailed or received the aforementioned documents and that they either refused to sign the declarations or did not respond to the request that they sign the declarations within a reasonable amount of time, petitioners will have satisfied this requirement."

Id. at 4. Applicant again believes that Exhibits A-D provided herewith show that Inventors Singh and Durbin are unreachable. Accordingly, Applicant believes that it should not be prejudiced by the lack of signatures from a three missing or uncooperative former employees, especially considering Applicant is able to supply the signatures of four additional joint inventors to support the declarations under 37 C.F.R. § 1.131 and 37 C.F.R. § 1.48.

Applicant therefore respectfully requests the suspension of the rules of §1.131 and § 1.48 requiring signatures from all joint inventors on the declarations. Applicant hereby authorizes charging of Deposit Account No. 50-2402 for any fee due in relation to this renewed Petition.

Applicant appreciates the consideration of this Petition and invites the Office of Petitions to contact the undersigned, should any matters be considered unresolved.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368

Durbin et al.

S/N: 09/681,017

Phone: 262-268-8181
tjz@zpspatents.com

Dated: October 2, 2008
Attorney Docket No.: GEMS8081.023

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 S. Wisconsin St.
Port Washington, WI 53074
262-268-8100



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EXHIBIT A

Intellectual Property Attorneys

August 20, 2008

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OCT 02 2008

Mr. Karamjeet Singh
N105 W14490 Wilson Circle
Germantown, WI 53022

RE: U.S. Patent Application 09/681,017
Title: METHOD AND SYSTEM TO REMOTELY ENABLE SOFTWARE-BASED
OPTIONS FOR A TRIAL PERIOD
Filing Date: November 22, 2000
Our Ref: GEMS8081.023

Dear Mr. Singh,

In recent months, our firm has been in correspondence with several GE Healthcare employees regarding the above-referenced U.S. patent application. You are listed as an inventor for this application, along with Mr. Kun Zhang and Ms. Winnie Durbin. However, it has come to our attention that you are no longer employed by GE Healthcare, nor are Mr. Zhang and Ms. Durbin. We were also informed that the original inventorship listed on the filed patent application is incorrect, and that Mr. David T. Mehring, Mr. Thomas L. Lamoureux, Mr. Hubert A. Zettel, and Mr. Timothy D. Butler should also be included as inventors. Mr. Mehring was the main contact person for the change.

To properly continue prosecution of this patent application, we must submit a petition to correct inventorship to the U.S. Patent and Trademark Office, including a new Declaration signed by all inventors, even those no longer employed by the assignee, GE Healthcare. Accordingly, enclosed herewith is a new Declaration and Power of Attorney. If you agree with this change of inventorship, we ask that you please sign and date this Declaration and return it to us no later than **September 10, 2008**.

Further, in order to overcome a rejection made in an Office Action from the U.S. Patent and Trademark Office, we worked with Mr. Mehring and Mr. Lamoureux to prepare a Rule 1.131 Declaration to show conception of the present invention before the filing date of the prior art reference used in the rejection against the claims of our application. This Declaration also requires the signature of all inventors. As such, enclosed herewith is a copy of the Declaration under 37 C.F.R. §1.131, including the Exhibits to be presented as proof of conception of the invention. As with the above Declaration, we ask that you please sign and date this Declaration and return it to us no later than **September 10, 2008**.

Zielkowski Patent Solutions Group, SC

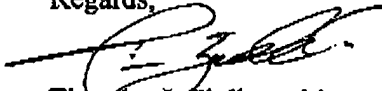
136 South Wisconsin St., Port Washington, WI 53074
262.268.8100 Fax 262.268.8185 zpspatents.com

August 20, 2008
Page 2 of 2

EXHIBIT A

Please review these documents and let me know if you would care to discuss the contents or have any revisions. Your cooperation in this matter is greatly appreciated. As our response to the U.S. Patent and Trademark Office is very time-sensitive, we again ask that you respond no later than **September 10, 2008**. If you have any questions or concerns, please feel free to contact us at any time.

Regards,



Timothy J. Ziolkowski
Direct Dial: 262-268-8181
tjz@zpspatents.com

Ziolkowski Patent Solutions Group, SC

136 South Wisconsin St., Port Washington, WI 53074
262-268-8100 Fax 262-268-8185 zpspatents.com

EXHIBIT B

| U.S. Postal Service | | CERTIFIED MAIL™ RECEIPT | |
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| (Domestic Mail Only; No Insurance Coverage Provided) | | | |
| For delivery information visit our website at www.usps.com | | | |
| OFFICIAL USE | | 8081023 | |
| Postage | \$ | 8081023 | Postmark Here |
| Return Receipt Fee (Endorsement Required) | \$ | | |
| Restricted Delivery Fee (Endorsement Required) | \$ | | |
| Total Postage & Fees | \$ | | |
| Sender's Information Sent to: Mr. Karamjeet Singh Street Address: N105 W14490 Wilson Circle City, State, ZIP+4: Germantown, WI 53022 | | | |
| Recipient's Information Addressed to: Karamjeet Singh N14490 Wilson Circle Germantown, WI 53022 | | | |
| Sender's Signature and Address I, Karamjeet Singh , certify that the above is a true and correct copy of the address of the addressee. Signature: _____ Printed Name: _____ Address: _____ City, State, ZIP+4: _____ | | | |
| Service Type <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Registered Mail <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> Restricted Delivery (Extra Fee) <input type="checkbox"/> Yes <input type="checkbox"/> No | | | |
| Delivery Instructions <input type="checkbox"/> If YES, enter delivery address below: <input type="checkbox"/> No <input type="checkbox"/> Is delivery address different from item 1? <input type="checkbox"/> Yes <input type="checkbox"/> No | | | |
| Additional Information <input type="checkbox"/> Signature <input type="checkbox"/> Agent <input type="checkbox"/> Addressee <input type="checkbox"/> Date of Delivery <input type="checkbox"/> Received by (Printed Name) <input type="checkbox"/> If YES, enter delivery address below: <input type="checkbox"/> No | | | |

Mr. Karamjeet Singh
 N105 W14490 Wilson Circle
 Germantown, WI 53022

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EXHIBIT C

Intellectual Property Attorneys

August 20, 2008

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OCT 02 2008

VIA CERTIFIED MAIL

Ms. Winnie C. Durbin
S30 W35911 Scuppernong Ct.
Dousman, WI 53118

RE: U.S. Patent Application 09/681,017
Title: METHOD AND SYSTEM TO REMOTELY ENABLE SOFTWARE-BASED
OPTIONS FOR A TRIAL PERIOD
Filing Date: November 22, 2000
Our Ref: GEMS8081.023

Dear Ms. Durbin,

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To properly continue prosecution of this patent application, we must submit a petition to correct inventorship to the U.S. Patent and Trademark Office, including a new Declaration signed by all inventors, even those no longer employed by the assignee, GE Healthcare. Accordingly, enclosed herewith is a new Declaration and Power of Attorney. If you agree with this change of inventorship, we ask that you please sign and date this Declaration and return it to us no later than **September 10, 2008**.

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Ziolkowski Patent Solutions Group, SC

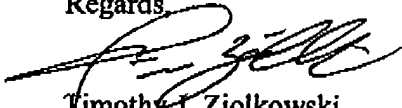
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August 20, 2008
Page 2 of 2

EXHIBIT C

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Regards,



Timothy J. Ziolkowski
Direct Dial: 262-268-8181
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Attorneys

Solutions Group, SC
3 St., Port Washington, WI 53074

Sent to Ms. Winnie C. Durbin
S30.WR5911 Scuppernon Ct
Steele Apt No.
or PO Box No.
Dousman, WI 53118
City State, Zip+4

PS Form 3901, August 2003

See Page 92 for Instructions

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State Items 1, 2, and 3. Also complete if Restricted Daily is desired. Our name and address on the reverse, we can return the card to you. This card to the back of the mallpooze, the front if space permits.

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